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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,654	04/14/2006	Hans Binder	4319.GLE.PT	2298
27472 7590 12/29/2009 BATEMAN IP LAW GROUP P.O. BOX 1319 SALT LAKE CITY, UT 84110				
EXAMINER VAN TERPOOL, LESTER L				
ART UNIT 3782		PAPER NUMBER		
MAIL DATE 12/29/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/575,654

**Applicant(s)**

BINDER ET AL.

**Examiner**

LESTER L. VANTERPOOL

**Art Unit**

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 27, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 35, lines 1 & 2 recites: "wherein the rail is tubular and has a lumen formed therein,".

The specification pages 1 – 5 filed on April 14, 2006 does not disclose, define, identify or describe "a lumen formed therein the tubular rail.

3. Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 52, lines 1 & 2 recite: "the rail has a tubular body defining a lumen"; and line 4 recites: "rail lumen and which extends into the lumen".

The specification pages 1 – 5 filed on April 14, 2006 does not disclose, define, identify or describe “the rail having a tubular body defining a lumen.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 35 recites the limitation “a lumen” in claim 35, line 1. There is insufficient antecedent basis for this limitation in the claim.

The specification pages 1 – 5 filed on April 14, 2006 does not disclose, define, identify or describe “a lumen formed therein the tubular rail.

6. Claim 52 recites the limitation “a lumen” in claim 52, line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 34, 35, 37, 38, 39, 40, 41, 42, 44, 45, 46, 48, 49, 50 & 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Bott (U.S. Patent Number 4277009).

Bott discloses at least one rail (54) extending essentially at the distance from the roof surface of the vehicle (12) and at least two supports (68) at the ends of the rail (54)

to attach the roof rack to the vehicle roof (12), wherein the rail (54) is defined by the elongated body having exterior walls extending along the length of the rail (54) and end face (i.e. See Front Edge Bottom End Surface of (54 & 58) in Figure 5) extending across the elongate body; wherein the rail (54) is shaped to have a curved (58) in the end areas defined by the exterior walls (See Figure 4 & 5) and wherein each curve (58) is held from below by the support (68) such that the support (68) attaches to the exterior wall of the rail (54) independent of the end face (i.e. See Front Vertical Edge Bottom End Surface of (54 & 58) in Figure 5), wherein the top surface of the support (68), when viewed in cross-section, forms the flat supporting surface (Figure 7) for the matching surface on the rail (54) (See Figure 5), wherein the matching surface of the rail (54) is flat when viewed in cross-section (See Figure 5), and wherein the underside of the rail (54) has the recess (See Figure 5) in the area of the curve to locate the support (68).

Regarding claim 35, Bott discloses the rail (54) being tubular and has the lumen (i.e. See Hollow Area / Interior / Inner Portion of (54) in Figure 5) formed therein, and wherein the roof rack further comprises the projection (72) which extends into the end of the rail (54) so as to extend into the lumen (i.e. See Hollow Area / Interior / Inner Portion of (54) in Figure 5), and wherein, the projection (72) has the shape which corresponds to the lumen (i.e. See Hollow Area / Interior / Inner Portion of (54) in Figure 5) of the rail (54) so as to engage the lumen (i.e. See Hollow Area / Interior / Inner Portion of (54) in Figure 5) of the rail (See Figure 5).

Regarding claim 37, Bott discloses the mounting plate (16) attaches to the bottom of the support (68) and wherein the end face (i.e. See Front Edge Bottom End Surface of (54 & 58) in Figure 5) of the rail (54) is disposed adjacent the mounting plate (16) (See Figures 4 & 5).

Regarding claim 38, Bott discloses the rail (54) extending at the distance from the roof of the vehicle (12), the rail (54) having the elongated body and having exterior walls disposed along the length of the rail (54) and the end face (i.e. See Front Edge Bottom End Surface of (54 & 58) in Figure 5) disposed across the elongated body; the curved portion (58) formed in the end area of the rail (54) and defined by the exterior walls (See Figure 4); and the support (68) attached to the curved portion so as to be attached to the body via the exterior walls and configured for attaching the rail (54) to the roof of the vehicle (12), the support (68) having the upper surface which is curved so as to be complementary to the lower surface of the curved portion (58) formed in the end area of the rail (54) (See Figure 5).

Regarding claim 39, Bott discloses the flat on the bottom and configured for attachment to the roof of the vehicle (12) (See Figures 4 & 5).

Regarding claim 40, Bott discloses the rail (54) has the recess (See Figure 5) formed in the underside of the exterior wall of the curved portion (58) and wherein the support (68) is disposed in the recess (See Figure 5).

Regarding claim 41, Bott discloses the bottom of the curved portion (58) and the top of the support (68) are flat when viewed in a cross-section taken laterally across the rail (54) (See Figures 4, 5 & 7).

Regarding claim 42, Bott discloses the rail (54) is tubular so as to have the hollow interior (See Figure 5), and wherein the roof rack (See Figure 5) comprises the projection (72) which is complementary in shape to the hollow interior (See Figure 5) of the rail (54) and which is disposed in the hollow interior (See Figure 5) of the tubular rail (54) (See Figures 4 & 5).

Regarding claim 44, Bott discloses the bottom of the curved portion (58) and the top of the support (68) have the curved shape in longitudinal cross-section (See Figure 7).

Regarding claim 45, Bott discloses the rail (54) has the step formed on the underside (See Figure 5) and wherein the support (68) is disposed adjacent the step such that the step locates the support (68).

Regarding claim 46, Bott discloses the mounting plate (16) located between the support (68) and the roof of the vehicle (12) (See Figure 4), and wherein the end of the rail (54) is disposed adjacent the mounting plate (16).

Regarding claim 48, Bott discloses the rail (54) extending at a distance from the vehicle, wherein the rail (54) comprises the elongate body defined by exterior walls extending along the length thereof and the end face (i.e. See Front Edge Bottom End Surface of (54 & 58) in Figure 5) extending across the length thereof, and wherein the end of the rail (54) has the curved portion (58) formed therein such that the end section (i.e. Lower Portion of (58) in Figure 4) of the rail (54) curves towards the surface of the vehicle (12) (See Figure 4);

the support (68) attached to the underside of the exterior walls of the curved portion (58) of the rail (54), the support (68) having the curved upper surface which is complementary to the lower surface of the curved portion (58) and having the lower surface configured for attachment to the vehicle (12) (See Figures 4 & 5).

Regarding claim 49, Bott discloses the rail (54) has the recess (See Figure 5) formed in the underside of the curved portion (58), and wherein the support (68) is located in the recess (See Figure 5).

Regarding claim 50, Bott discloses the rail (54) has the step formed in the underside of the curved portion (58) (See Figure 5), and wherein the support (68) is disposed against the step (See Figure 5).



Regarding claim 53, Bott discloses the bottom of the curved portion (58) and the top of the recess are curved in longitudinal cross-section and flat in lateral cross section (See Figures 4 & 5).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 36, 43, 47, 51 & 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bott (U.S. Patent Number 4277009) in view of Stapleton (U.S. Patent Number 7204396).

Bott discloses the roof rack further comprises the mounting plate (16) and wherein the projection (72) extends upwardly from the support (68) (See Figure 4).

However, Bott does not disclose the projection extending upwardly from the mounting plate.

Stapleton teaches the projection (66) extending upwardly from the mounting plate (26) (See Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the projection extending upwardly from the mounting plate as taught by Stapleton with the roof rack of Bott in order to enhance anchoring and reduce excess movement.

Regarding claim 43, Bott discloses the mounting plate (16) attached to the bottom of the support (68) (See Figure 4).

However, Bott does not disclose the projection is disposed on the mounting plate.

Stapleton teaches the projection (66) is disposed on the mounting plate (26) (See Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the projection disposed on the mounting plate as taught by Stapleton with the roof rack of Bott in order to enhance anchoring and reduce excess movement.

Regarding claim 47, Bott does not disclose the mounting plate has the projection disposed thereon such that the projection extends into hollow interior of the end of the rail.

Stapleton teaches the mounting plate (26) having the projection (66) disposed thereon such that the projection extends into hollow interior of the end of the rail (See Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the mounting plate has the projection disposed thereon such that the projection extends into hollow interior of the end of the rail as taught by Stapleton with the roof rack of Bott in order to enhance anchoring and reduce excess movement.

Regarding claim 51, Bott discloses the mounting plate (16) attached to the bottom of the support (68) (See Figure 4).

However, Bott does not disclose the mounting plate having the projection configured for engaging the recess in the end face of the rail.

Stapleton teaches the mounting plate (26) having the projection (66) configured for engaging (See Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the mounting plate having the projection configured for engaging as taught by Stapleton with the roof rack of Bott in order to enhance anchoring and reduce excess movement.

Regarding claim 52, Bott discloses the rail (54) having the tubular body defining the lumen (i.e. See Hollow Area / Interior / Inner Portion of (54) in Figure 4 & 5), and wherein the roof rack has the mounting plate (16) attached to the bottom of the support (68) (See Figure 4),

the projection (72) extending upwardly therefrom having the shape which corresponds to the rail lumen (i.e. See Hollow Area / Interior / Inner Portion of (54) in Figures 4 & 5) and which extends into the lumen (i.e. See Hollow Area / Interior / Inner Portion of (54) in Figures 4 & 5).

However, Bott does not disclose the mounting plate having the projection extending upwardly therefrom.

Stapleton teaches the mounting plate (26) having the projection (66) extending upwardly therefrom.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the projection extending upwardly from the mounting plate as taught by Stapleton with the roof rack of Bott in order to enhance anchoring and reduce excess movement.

11. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bott (U.S. Patent Number 4277009) in view of Mohr (German Patent Number DE 4422421 C1).

Bott does not disclose the rail is formed by a single piece comprising a generally straight portion and a curved end portion.

Mohr teaches the rail (1) is formed by a single piece comprising a generally straight portion (i.e. See Left Side Portion of (1) in Figures 1 & 2) and a curved end portion (i.e. See Right Side Portion of (1) in Figures 1 & 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the rail formed by a single piece comprising a generally straight portion and a curved end portion.

### ***Response to Arguments***

12. Applicant's arguments filed August 27, 2009 have been fully considered but they are not persuasive.

Applicant argues, the prior art does not show a support that attaches to the curved exterior walls of the rail, but instead teaches attachment to the end face of the rails.

Examiner disagrees, Bott '009 teaches the curve (58) being held from below by the support (68) such that the support (68) attaches to the exterior wall of the rail (54) independent of the end face (i.e. See Front Vertical Edge Bottom End Surface of (54 & 58) in Figure 5) (See Figure 5).

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESTER L. VANTERPOOL whose telephone number is

(571)272-8028. The examiner can normally be reached on Monday - Friday (8:30 - 5:00) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. L. V./  
Examiner, Art Unit 3782

/Nathan J. Newhouse/  
Supervisory Patent Examiner, Art Unit 3782